

## REMARKS

The Office action incorrectly listed claims 1-13 as pending in the application. The preliminary amendment sent on January 23, 2002 cancelled claims 1-11. Therefore, only claims 12 and 13 are pending.

Responsive to the restriction requirement set forth in the Office action, applicants affirm election of Group I, claim 12 for examination. This election is made with traverse. Inventorship is unchanged.

→ Responsive to the election of a single species requirement set forth in the Office action, the indoline compound (101) from Example 1, page 12 of the specification is elected for initial examination.

On finding claims directed to the elected species to be allowable, withdrawal of the election requirement and consideration of the patentability of the remainder of the Markush group is also respectfully solicited.

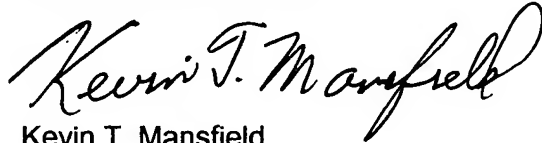
There is precedent for making the election and keeping the non-elected claim pending during prosecution. Applicants note the *In re Ochiai* [37 USPQ2d 1127(CAFC, 1995)] and *In re Brouwer* [37 USPQ2d 1663 (CAFC, 1995)] Court decisions and the Commissioner of Patents and Trademarks' OG Notice concerning them entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer*, and 35 U.S.C. § 103(b)", 1184 Off. Gaz. Pat. Office 86 (March 26, 1996) in this regard. According to the Guidance

... to facilitate examination under §103, where product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

In accord with the above guidelines, on finding the product claim 12 to be allowable, Applicant requests rejoinder for claim 13.

An Office Action on the merits of this application is respectfully awaited. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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KTM21844OA1

**JUL 18 2003**